

In re Patent Application of:

MAY ET AL.

Serial No. 10/790,479

Filing Date: **MARCH 1, 2004**

REMARKS

The Examiner is thanked for the thorough examination of the present application. Submitted herewith is a signed Terminal Disclaimer on behalf of the Assignee, TeamOn Systems, Inc., specifying the appropriate portion of the patent term being disclaimed. Accordingly, it is requested that the provisional double patenting rejection be withdrawn.

Independent Claims 1 and 9 have been amended to incorporate the subject matter of their respective dependent Claims 8 and 15, which have been canceled for consistency therewith. Independent Claims 16 and 20 have been amended similarly to Claims 1 and 9. No new matter is being added.

In view of the amendments and the supporting arguments presented in detail below, it is submitted that all of the claims are patentable.

I. The Claimed Invention

The present invention is directed to a mobile wireless cellular communications device. As recited in amended independent Claim 1, for example, the device includes a wireless cellular transceiver and a controller for cooperating therewith for receiving text messages from a wireless communications network. The device further includes a headset output connected to the controller. The controller is for switching between a normal message mode and an audio message mode based upon a connection between the headset output and a headset. Moreover, when in the audio message mode, the controller outputs at least one audio

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message comprising speech generated from at least one of the received text messages via the headset output.

Independent Claim 9 is directed to a related cellular communication system, independent Claim 16 is directed to a related method, and independent Claim 20 is directed to a related computer-readable medium. Each of these claims has been amended similarly to Claim 1 to recite that the text messages are sent from a wireless cellular communications network/received at a mobile wireless cellular communications device.

II. The Claims Are Patentable

The present application includes independent Claims 1, 9, 16, and 20. As noted above, each of these claims has been amended to include subject matter as found in original Claims 8 and 15, which have been canceled. The Examiner rejected Claims 8 and 15 based upon U.S. patent publication no. 2003/0218642 to Sakayori et al. in view of U.S. Patent No. 6,823,184 to Nelson. Sakayori et al. is directed to a device for operating an apparatus such as a copier, facsimile machine, printer, etc., that allows a user to input an instruction for operating the apparatus or receive information from the apparatus without using eyesight (i.e., an audible control mode). The Examiner notes that the device switches from the non-visual mode to the visual mode upon disconnecting a headset (paragraph 0215), and that in one embodiment the device may use infrared or wireless communications to communicate with a PC (paragraph 0265).

While the Examiner correctly acknowledges that Sakayori

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et al. fails to teach or fairly suggest a wireless cellular transceiver and/or text messages sent from a wireless cellular communications network/received at a mobile wireless cellular communications device, the Examiner contends that Nelson provides these noted deficiencies. Nelson is directed to a PDA with "quiet call technology" that allows a user to participate in a call when in a "quiet" environment by typing text on the PDA, and the text is converted to speech for the recipient. See, e.g., col. 2 lines 22-30 and col. 4, lines 16-27.

It is respectfully submitted that there is no proper motivation or suggestion to combine the references as the Examiner proposes. More particularly, Nelson is directed to a method for placing a cellular PDA device in a VISUAL (i.e., keyboard typing/touchscreen) mode so that the user can participate in a call even when he is in a location where he cannot speak. See, e.g., col. 7, lines 5-10. Yet, Sakayori et al. is directed to a control device for copiers, etc., having a primary purpose of allowing a user to operate the device and receive information therefrom NON-VISUALLY (i.e., audibly) without having to read a display in a non-visual operation mode. See, e.g., paragraph 0018, abstract of Sakayori et al.

Accordingly, making the selective combination of references proposed by the Examiner would render the Sakayori et al. device unsatisfactory for its intended purpose. That is, taking all of the teachings of the prior art as a whole, one skilled in the art would be taught from Nelson that in a normal mode incoming cellular calls would be received in a typical

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fashion (i.e., the user would listen and talk as normal), whereas in a "quiet call" mode the user would "converse" using a visual and quiet entry device (i.e., keypad/touchscreen). Conversely, Sakayori et al. teaches that in a normal (i.e., visual) mode a user would be required to look at and operate a control panel on a copier, etc., but in a non-visual operation mode the user would instead use audible commands to operate the copier. Accordingly, Nelson requires the exact opposite control approach from that which Sakayori et al. seeks to implement, which would simply render Sakayori et al. device unsatisfactory for its intended purpose. More particularly, the selective combination proposed by the Examiner would impermissibly change the principle of operation of Sakayori et al., and one of ordinary skill in the art would thus have been taught away from attempting such a combination.

As such, it is submitted that independent Claims 1, 9, 16, and 20 are patentable over the prior art. Their respective dependent claims, which recite yet further distinguishing features, are also patentable over the prior art and require no further discussion herein. To find otherwise would require the impermissible use of the claimed invention in hindsight as a template or roadmap to piece together the teachings of the prior art.

CONCLUSIONS

In view of the foregoing, it is submitted that all of the claims are patentable. Accordingly, a Notice of Allowance is

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respectfully requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

A handwritten signature in cursive script, reading "John F. Woodson II", written over a horizontal line.

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 25th day of January, 2006.

A handwritten signature in cursive script, appearing to read "Justin Dan", is written over a horizontal line.